

REMARKS

The interview with examiner Edmond Lee on November 16, 2005 is acknowledged with appreciation. The examiner's interview summary is accurate as to what transpired at the interview.

Claims 7-12 are rejected because the specification does not enable one skilled in the art to make and use the invention commensurate in scope with these claims and "an opening is needed for the material to pass from the interior to the exterior." As discussed at MPEP sections 2164.01-2164.08, all that is required is that any person skilled in the art be able to practice the invention without undue experimentation. Applicant's disclosure at, for example, page 6, lines 20-22 states that "plastics material is moved or otherwise extruded through holes 17 during formation of monolithic compliant member 10...." This would enable one to practice the invention without undue experimentation. On this basis, reconsideration of the rejection under 35 U.S.C. 112, first paragraph is requested.

Claim 7 is amended by adding reference to an opening.

Claims 3, 9 and 16 have been amended to be in independent form. Claims 3 and 9 require the step of "determining the weight of the plastics material being extruded onto the interior surface of the cap, and ceasing the extruding step once the weight of plastics material extruded onto the interior surface reaches a predetermined weight..." and claim 16 requires "a pellet of a predetermined amount is placed on the interior surface and the pellet is compressed during the moving step to create the cap liner and the grip portion." As discussed at the interview the prior art does not teach or suggest the above-quoted steps. Allowance of claims 3, 9 and 16 is requested.

Claim 1 has been amended to include the limitations of claim 2. Claim 1 recites the step of moving "comprises applying the plastics material to the interior surface of the cap and then compressing the plastics material to form the cap liner in the interior region of the cap and form the grip portion of the exterior surface on the cap." The rejection of claim 2 (now amended claim 1) acknowledges that Bloomdahl et al (U.S. Publication No. 2002/0113032) does not teach compressing the material and urges that such is obvious. Bloomdahl et al. does not teach or suggest the steps of applying and then compressing as recited in amended claim 1 to form a monolithic cap liner and grip portion member from plastics material applied to the interior surface of the cap. Bloomdahl et al. discloses injection molding of exterior portion 40 (grip) and

interior portion 50 (seal) and relates that “[t]he present invention also contemplates that a third material, or even more materials, may be molded with multi-injection processes to form a closure comprising three or more materials” (paragraph No. 0048, first line). Bloomdahl et al. also states “[t]he exterior, surface portions of such a gripping tab may be formed with a different material, such as the material comprising the piece 40 and/or comprising the piece 50” (paragraph No. 0049). This disclosure in Bloomdahl et al. of different liner and grip materials suggests that the step of injecting the materials is from different injectors, perhaps one inside the cap and one outside the cap. The statement in the rejection that it would have been obvious to compress the material in Bloomdahl et al. to mold the grip and liner appears to be based on hindsight, not a teaching or suggestion in Bloomdahl et al. Reconsideration and withdrawal of the rejection of claims 1 and 3-6 is requested.

Claims 7-12 are rejected as unpatentable over Bloomdahl et al. and Hock et al. The rejection acknowledges Bloomdahl et al. does not compress material in the cap and urges that it would have been obvious to compress the material of Bloomdahl et al as taught by Hock et al.

Hock et al. (U.S. Patent No. 6,696,123) discloses a pellet 20 to form a liner 20a, 20b or 20c, but does not teach or suggest steps to form a monolithic cap liner and grip portion member from a pellet as recited in claims 3, 9 and 16. One of ordinary skill in the art would not have been motivated to use the compression molding step of Hock et al. in the process of Bloomdahl et al. since this would not permit the use of different materials as disclosed by Bloomdahl et al. Hock et al.’s compression step involves one material, not two or more. Bloomdahl et al. discloses that the exterior portion 40 (grip) and interior portion 50 (seal) may be of the same material, but Bloomdahl et al. would use the same steps (and apparatus) for both the same and different materials, which steps are not the steps of 3, 9 and 16 of compressing a pellet on the cap interior to form a monolithic grip and liner as discussed above.

For at least the above reasons, it appears that the rejection of claims 7-12 results from an improper hindsight attempt to provide the invention of applicant’s claims. The rejection does not provide a proper analysis of what is taught by the prior art such that there is motivation for the combination of these two references. This is evident since use of Hock et al.’s step of compression in Bloomdahl et al. would not enable Bloomdahl et al.’s liner and grip to be of different materials. Thus, it would not have been obvious to replace Bloomdahl et al.’s steps

with Hock et al.'s step of compression as urged in the rejection. Reconsideration and allowance of claims 7-12 is requested.

New claims 13-16 are added. Claim 13 is directed to a method comprising providing a cap and compressing a plastics material on the cap interior surface through the holes to create a monolithic compliant member having a cap liner located on the interior surface of the cap and... a grip portion on the exterior surface of the cap. As discussed above, Bloomdahl et al. does not teach or suggest compressing a material through the cap holes. Bloomdahl et al. discloses injecting material which can be different materials (for the liner and grip, respectively) which connotes plural injections, not one compression as recited in claims 13-16. Modification of Bloomdahl et al. that would have resulted in the method of claims 13-16 would not have been obvious.

Accordingly, claims 1-16 are allowable and such action is, respectfully, requested.

If there are any other matters that need attention the examiner is invited to telephone the undersigned so that they may be promptly addressed.

A check for \$600 for three additional independent claims is enclosed. It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees, be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 02-1010 (5723-70259).

Respectfully submitted,

BARNES & THORNBURG



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